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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,560	08/28/2003	Eric D. Fox	67519.001037	7600
<div>21967      7590      01/09/2008</div> <div>HUNTON &amp; WILLIAMS LLP</div> <div>INTELLECTUAL PROPERTY DEPARTMENT</div> <div>1900 K STREET, N.W.</div> <div>SUITE 1200</div> <div>WASHINGTON, DC 20006-1109</div>				
			<div>EXAMINER</div> <div>BATTULA, PRADEEP CHOUDARY</div>	
			<div>ART UNIT</div> <div>3722</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE</div> <div>01/09/2008</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/650,560	<b>Applicant(s)</b> FOX, ERIC D.	
	<b>Examiner</b> Pradeep C. Battula	<b>Art Unit</b> 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7,9,15,23,31-33 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7,9,15,23,31-33 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

**This action is in response to the reply to a Final Rejection filed on December 11, 2007**

### ***Claim Objections***

Claim 7 is objected to because of the following informalities: the limitation of "the cover" should be changed to "a cover" since there is no antecedent basis for this limitation. Appropriate correction is required.

### ***Allowable Subject Matter***

The indicated allowability of former Claims 8 and 39 and current Claims 9 and 41 is withdrawn in view of the new interpretation of Hoonsbeen. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 7, 9 and 15 – 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Honnsbeen.

Hoonsbeen discloses in Fig. 1 and 2, an identification card and a method for securing an item comprising: a cavity (P) in a first portion (C) on a first face (top of the first portion where the second portion item 20a mates) which is within the first portion; the cavity operable to receive an item (15); a second portion/cover (20) connectable to the first portion operable to secure the item (P) in the cavity and to permit the item to be

removably inserted from the cavity; a securing mechanism (11a and 20C; both on peripheral edge of cavity and second portion) operable to affix the cover (20) to the card; wherein the securing mechanism comprises a groove or recessed portion (11a) in the cavity operable to removable secure the second portion (20) to the identification card (which inherently would inherently comprise one face), an indented portion (20b) relative to top portion (20a) and operable with the first portion to removable connect the first portion to the second portion, and a distal portion (20c) along the edge of the second portion; a magnetic strip (25 and 26) on the face of the card and operable to store information of the issuer of the card, and separate from a projection of the recess onto the face of the identification card; and wherein the card comprises a transparent face.

In regards to Claim 9, Hoonsbeen further discloses wherein a second face has an at least partially transparent portion to allow viewing of the item in the cavity (Column 1, Lines 59 – 67)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 23, 31 – 33, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoonsbeen and Lam et al. (Lam).

Hoonsbeen discloses in Fig. 1 and 2, an identification card comprising: a first face and second face parallel to the first face (the examiner considers this to be the interior of the front and back walls of the holder) a recess (P) operable to receive an insert (15) and disposed on one of the first and second faces; a slidable cover (20) operable to secure the item (P) in the cavity and to permit the item to be removably inserted from the cavity; a securing mechanism (11a and 20C) operable to affix the cover (20) to the card; wherein the securing mechanism comprises a groove or recessed portion (11a) in the cavity operable to removable secure the cover (20) to the identification card, and a distal portion (20c) along the edge of the cover; a magnetic strip (25 and 26) operable to store information of the issuer of the card on the first face, and disposed on the card at a location separate from a projection of the recess onto the first face of the identification card; and wherein the card comprises a transparent face.

However, Hoonsbeen does not disclose wherein the insert is coupleable to a picture to permit the picture to be removably inserted from a recess.

Lam et al discloses in Fig. 4, an insert (56) coupleable to a picture (58) to permit the picture to be removably inserted form a recess (38) from card (20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hoonsbeen's card with an insert having a coupled picture as taught by Lam et al for providing a mounting platform in which to prevent movement of the inserted picture.

In regards to **Claim 23**, the method of the picture being personally selected by the cardholder to customize the identification card according to one or more particular personal preferences of the cardholder, does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious form a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would have been obvious to customize the cards in any desired manner.

In regards to Claim 41, Hoonsbeen modified by Lam further discloses wherein a second face has an at least partially transparent portion to allow viewing of the item in the cavity (Column 1, Lines 59 – 67; Hoonsbeen).

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### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB  
Patent Examiner  
January 4, 2008

  
**MONICA CARTER**  
SUPERVISORY PATENT EXAMINER